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10/607,753	06/26/2003	Michael A. Rothman	42P16431	7337

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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/607,753

Applicant(s)

ROTHMAN ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/646,606 [hereinafter '606 application] and the claims of copending Application No. 10/302281 [hereinafter '281 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Taking claim 1 as an exemplary claim, the '606 and '281 applications contain the subject matter claimed in the instant application. As per claim 1, all applications are claiming common subject matter, as follows:

A method, comprising:

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receiving a request to perform a task ...; and

executing the task ... independent of an operating system

Although all claims are not claiming the processing steps in the same order but it would have been obvious to a person skill in the art to recognize that the scope of the claims are identical.

As per independent claims 14, 23 and 27, they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

As per dependent claims, they are depending on the rejected claims. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claim 14, paragraph 0046 of the specification provides intrinsic evident that a machine-readable medium can include propagated signals, as such, it is

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not fall within a statutory category of invention (Please see MPEP 2106, "Interim Guideline for Patent Examiner for Patent Subject Matter Eligibility").

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsai et al. [US Patent Application No 2003/0229694].

7. As per claim 1, Tsai discloses the invention as claimed including a method, comprising:

receiving a request to perform a task at a remote computer [i.e. the working computer] from a caller computer [i.e. the remote computer] on a network [i.e. the packets of command and information are delivered to the computer control firmware of the working computer] [Figure 1; paragraph 0021, lines 11-16; and paragraph 0022, lines 5-10]; and

executing the task at the remote computer independent of an operating system of the remote computer [i.e. the computer control firmware transforms the packets to command and

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information of the working computer to control the working computer] [paragraph 0008; paragraph 0021, lines 16-19; and paragraphs 0022 and 0023].

8. As per claim 2, Tsai discloses initializing a listening mechanism to receive the request [i.e. the computer control firmware] [116, Figure 1; and paragraph 0021].

9. As per claim 3, Tsai discloses initiating an interrupt to a processor of the remote computer by the listening mechanism when the request is received at the remote computer [paragraphs 0010 and 0011].

10. As per claim 5, Tsai discloses wherein the request is received at the remote computer in the form of a request packet [i.e. the packets are delivered to the computer control firmware] [paragraph 0021, lines 16-20].

11. As per claim 6, Tsai discloses wherein the request packet comprises programming code to be executed by the remote computer [i.e. the packets of commands and information] [paragraphs 0008 and 0011].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4, 7-21, 23-25, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. [US Patent Application No 2003/0229694], in view of Barnstijn et al. [US Patent No 5,715,387].

14. As per claim 4, Tsai does not specifically disclose periodically polling a network interface of the remote computer by the listening mechanism to determine if the remote computer has received a request. Barnstijn discloses periodically polling a network interface of the remote computer by the listening mechanism to determine if the remote computer has received a request [i.e. waiting certain amount of time] [col 6, lines 5-9; and col 10, lines 37-61]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would allow both input and output events to physically initiate using the target system's hardware while one or more applications under development reside and executed in the host system development environment [Barnstijn, col 3, lines 21-28].

15. As per claim 7, Tsai does not specifically disclose wherein the programming code is a scripting language. Barnstijn discloses wherein the programming code is a scripting language [i.e. the program instructions] [col 2, lines 3-7]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide a special application loader program that

communicates with the operating system of the target device and interrogates the status of the target system code and data memory [Barnstijn, col 3, lines 39-44].

16. As per claim 8, Tsai discloses wherein the request packet comprises an interface packet to call a pre-defined function of firmware of the remote computer [i.e. reboot or reset of BIOS] [paragraphs 0009 and 0011].

17. As per claim 9, Tsai does not specifically disclose wherein the request packet comprises a memory packet to access contents of a memory address of the remote computer. Barnstijn discloses wherein the request packet comprises a memory packet to access contents of a memory address of the remote computer [i.e. address reference] [Figure 9; col 2, lines 7-15; and col 1, lines 26-38]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide a special application loader program that communicates with the operating system of the target device and interrogates the status of the target system code and data memory [Barnstijn, col 3, lines 39-44].

18. As per claim 10, Tsai does not specifically disclose wherein the request packet comprises a data structure packet to access data of a data structure of the remote computer. Barnstijn discloses wherein the request packet comprises a data structure packet to access data of a data structure of the remote computer [i.e. relocatable program] [col 11, lines 26-38; and col 12, lines 2-5]. It would have been obvious to a person skill in the art at the time the invention was

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made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide a special application loader program that communicates with the operating system of the target device and interrogates the status of the target system code and data memory [Barnstijn, col 3, lines 39-44].

19. As per claim 11, Tsai does not disclose returning a response to the caller computer containing indicia relating to performance of the task. Barnstijn discloses returning a response to the caller computer containing indicia relating to performance of the task [i.e. return the status of the operation] [617, Figure 6; and col 9, lines 18-20]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide an advantage for the application developer to engage in more sophisticated diagnostic tools to aid in the application program development [Barnstijn, col 3, lines 25-28].

20. As per claim 12, Tsai does not specifically disclose wherein the response is returned to the caller computer in the form of a response packet. Barnstijn discloses wherein the response is returned to the caller computer in the form of a response packet [col 9, lines 19-23]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide an advantage for the application developer to engage in more sophisticated diagnostic tools to aid in the application program development [Barnstijn, col 3, lines 25-28].

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21. As per claim 13, Tsai does not specifically disclose wherein the response comprises an error message if the remote computer fails to successfully execute the task. Barnstijn discloses wherein the response comprises an error message if the remote computer fails to successfully execute the task [col 3, lines 39-48]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Tsai and Barnstijn because the teaching of Barnstijn would provide an advantage for the application developer to engage in more sophisticated diagnostic tools to aid in the application program development [Barnstijn, col 3, lines 25-28].

22. As per claim 14, it is rejected for similar reasons as stated above in claims 1 and 11.

23. As per claim 15, Tsai discloses wherein the request packet comprises an interface packet to call a programmatic interface of firmware of the remote computer [paragraph 0011].

24. As per claim 16, it is rejected for similar reasons as stated above in claim 9.

25. As per claim 17, it is rejected for similar reasons as stated above in claim 10.

26. As per claim 18, Tsai discloses wherein the request packet comprises programming code to be executed under the control of firmware of the remote computer [116, Figure 1; and paragraph 0021].

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27. As per claim 19, it is rejected for similar reasons as stated above in claim 2.

28. As per claim 20, it is rejected for similar reasons as stated above in claim 4.

29. As per claim 21, it is rejected for similar reasons as stated above in claim 3.

30. As per claim 23, it is rejected for similar reasons as stated above in claims 1 and 11.

Furthermore, Tsai discloses a processor; a network interface operatively coupled to the processor; and at least one flash device operatively coupled to the processor on which firmware instructions are stored [Figure 1; and paragraph 0010].

31. As per claim 24, it is rejected for similar reasons as stated above in claim 7.

32. As per claim 25, Barnstijn discloses wherein receiving the request packet comprises storing at least a portion of the request packet in the network interface [i.e. accumulate serial characters] [704, Figure 7; and col 9, lines 47-col 10, lines 1].

33. As per claim 27, it is rejected for similar reasons as stated above in claims 1 and 11.

34. As per claim 28, Tsai discloses wherein the request packet includes arguments for a protocol interface to be executed by the at least one remote computer [i.e. commands] [paragraph 0011].

35. As per claim 29, it is rejected for similar reasons as stated above in claim 7.

36. As per claim 30, Barnstijn discloses wherein the request packet is sent to the at least one remote computer at a pre-set time designated at the caller computer [col 6, lines 5-9].

37. Claims 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. [US Patent Application No 2003/0229694], in view of Barnstijn et al. [US Patent No 5,715,387], and further in view of Maciesowicz [US Patent No 6,907,482].

38. As per claim 22, Tsai and Barnstijn do not specifically disclose wherein the plurality of instructions to operate in accordance with an Extensible Firmware Interface (EFI) framework standard. Maciesowicz discloses wherein the plurality of instructions to operate in accordance with an Extensible Firmware Interface (EFI) framework standard [col 11, lines 12-16; and col 13, lines 18-21]. It would have been to a person skill in the art at the time the invention was made to combine the teaching of Tsai, Barnstijn and Maciesowicz because the teaching of Maciesowicz would provide hardware independent video display facilitated through firmware services that abstract video hardware and expose an interface to an operating system [Maciesowicz, col 1, lines 15-19].

39. As per claim 26, it is rejected for similar reasons as stated above in claim 22.

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40. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached at (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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